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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT PAPER NUMBER

3623

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/076,029

Applicant(s)

SIMON ET AL.

Examiner

Susanna M. Diaz

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*MW*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003 and 28 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) 10-31, 37-48, 53-70 and 74-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 32-36, 49-52 and 71-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6, 11, 15</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Non-Final Office action is responsive to Applicant's Response to Restriction Requirement filed January 28, 2004 and Applicant's Response to the Requirement for Information under 37 CFR §1.105 filed October 20, 2003.

Applicant elects Group I (claims 1-9, 32-36, 49-52, and 71-73) with traverse; however, Applicant presents no arguments in support of the traversal. Therefore, Applicant has effectively elected without traverse instead.

Non-elected claims 10-31, 37-48, 53-70, and 74-78 stand as withdrawn. Please cancel these claims in response to the instant Office action.

Claims 1-9, 32-36, 49-52, and 71-73 are presented for examination.

2. Examiner appreciates Applicant's thorough Response to the Requirement for Information under 37 CFR §1.105, which sufficiently addresses issues raised by the Examiner in the Requirement for Information under 37 CFR §1.105.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9, 32-36, 49-52, and 71-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borders et al. (US 2001/0047285) in view of the article "E-Business in the New Beverage Marketplace."

Borders discloses a computer-readable medium for scheduling delivery vehicle visits to a customer, said computer-readable medium comprising computer-executable instructions for performing the steps of:

[Claim 1] (1) receiving requests from a user that a first delivery vehicle visit be made to said customer within a first particular time window on a first day, and that a second vehicle delivery visit be made to said customer within a second particular time window on a second day (¶¶ 47, 57, 59, 64 -- The fact that some customers have customer order histories and multiple deliveries may be aggregated into one delivery signifies that a user may request multiple deliveries corresponding to different orders and potentially on different days. Therefore, it is understood that the disclosed scheduling methodology is utilized for each individual order and corresponding delivery request);

(2) determining whether to schedule said first delivery vehicle visit within said first particular time window on said first day (¶¶ 47, 57);

(3) determining whether to schedule said second delivery vehicle visit within said second particular time window on said second day (¶¶ 47, 57);

(4) in response to a combination of: (a) said request, and (b) a determination in Step (2) that said first delivery vehicle visit should be scheduled within said first particular time window on said first day, scheduling said first delivery vehicle visit to be made within said first particular time window on said first day (¶¶ 47, 57); and

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(5) in response to a combination of: (a) said request, and (b) a determination in Step (3) that said second delivery vehicle visit should be scheduled within said second particular time window on said second day, scheduling said second delivery vehicle visit to be made within said second particular time window on said second day (¶¶ 47, 57);

[Claim 2] wherein said Step (2) includes determining whether it would be possible to make said first delivery vehicle visit within said first particular time window on said first day (¶¶ 47, 57); and

Step (3) includes determining whether it would be possible to make said second delivery vehicle visit within said second particular time window on said second day (¶¶ 47, 57);

[Claim 3] wherein said Step (2) includes determining whether it would be economically desirable to make said first delivery vehicle visit within said first particular time window on said first day (¶ 57 -- A cost module is used to help determine if a requested delivery is feasible on the desired date and time); and

Step (3) includes determining whether it would be economically desirable to make said second delivery vehicle visit within said second particular time window on said second day (¶ 57 -- A cost module is used to help determine if a requested delivery is feasible on the desired date and time);

[Claim 4] wherein said first delivery vehicle visit is a first delivery (¶¶ 47, 57, 59, 64);

said first delivery vehicle visit includes a first set of items (¶¶ 47, 57, 59, 64 --  
The fact that some customers have customer order histories and multiple deliveries may

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be aggregated into one delivery signifies that a user may request multiple deliveries corresponding to different orders and potentially on different days);

said second delivery vehicle visit is a second delivery (§§ 47, 57, 59, 64); and

said second delivery includes a second set of items (§§ 47, 57, 59, 64 -- The fact that some customers have customer order histories and multiple deliveries may be aggregated into one delivery signifies that a user may request multiple deliveries corresponding to different orders and potentially on different days);

[Claim 7] wherein said computer-readable medium comprises computer-executable instructions for performing Steps (1), (2), (3), (4), and (5) in real time (§§ 47, 57);

[Claim 8] wherein said computer-readable medium further comprises computer-executable instructions for displaying a confirmation message to said user confirming that said first and second delivery vehicle visits have been scheduled, and wherein said step of displaying a confirmation message is executed in response to a combination of:

(a) said request;

(b) a determination in Step (2) that said first delivery vehicle visit should be scheduled within said first particular time window on said first day; and

(c) a determination in Step (3) that said second delivery vehicle visit should be scheduled within said second particular time window on said second day (§§ 47, 88-89).

Regarding claims 1-9, Borders discloses a scheduling system that allows customers to schedule the delivery of an item each time an item is ordered. However,

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Borders does not expressly teach that multiple, reoccurring deliveries (e.g., deliveries on different days, but during the same particular time window) may be scheduled through one request. The article "E-Business in the New Beverage Marketplace" discusses various online grocers, including Webvan (the assignee of the Borders patent application). This same article states the following regarding the practice of "automatic replenishment":

One solution employed by some online grocers has been to take impulse out of the equation altogether. 'Automatic replenishment' programs that provide for weekly or bi-weekly delivery of specified items achieve this. Repeat customers can get regular deliveries of Tab, for instance. Customer loyalty programs, such as small discounts, may provide the right incentive for people to sign up for this service. Such programs may also appeal to people as a convenient time-saver. (¶ 46)

Not only is Webvan (the assignee of the Borders patent application) mentioned in the article "E-Business in the New Beverage Marketplace," but Borders also gives delivery scheduling priority to its preferred customers. These customers include those who have a high shipment frequency and volume (¶¶ 92, 96). For example, the more "popular" delivery windows may be reserved for the higher ranking customers (¶ 128). Clearly, Borders' invention aims at encouraging repeat business from its frequent and high volume customers; therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enhance Borders' invention with the ability to provide customers with the option of requesting reoccurring deliveries of the same items (as taught by the article "E-Business in the New Beverage Marketplace") during the same particular time window, but on multiple

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days (the capabilities of which are already presented in Borders) in order to encourage repeat patronage from Borders' most profitable customers by offering them a more convenient solution to scheduling reoccurring deliveries (as suggested by the article "E-Business in the New Beverage Marketplace"). This modified version of Borders teaches the following limitations: wherein said first set of items includes substantially all of the items delivered during said first delivery (e.g., Tab soda) and said second set of items includes substantially all of the items within said first set of items (e.g., a repeat weekly or bi-weekly delivery of Tab soda), as per claim 5; and wherein said single request comprises a definition of said first set of items (e.g., Tab soda), an indication that said first set of items should be delivered within said particular time window on said first day (e.g., Tab soda will be delivered this Monday between 8 and 10 am), and an indication that said first set of items should be delivered, according to a reoccurring delivery schedule, within said particular time window on at least one day other than said first day (e.g., another shipment of Tab soda will be delivered the following Monday between 8 and 10 am), as per claim 6.

In reference to claim 9, Borders teaches the scheduling of the delivery of items, yet Borders does not expressly disclose the scheduling of a first and second pick-up. However, as part of its comparison of various online grocery services, the article "E-Business in the New Beverage Marketplace" also explains how the company ShopLink.com not only allows a customer to request a delivery of groceries, but it also facilitates dry cleaning (¶ 47). Furthermore, Official Notice is taken that it is old and well-known in the art to schedule a dry cleaning pick-up from a customer's location.



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This practice saves the customer the time of having to drop off his/her dry cleaning at the dry cleaner's location, thereby making the overall process more convenient to the customer. Also, it should be noted that a delivery truck's route is planned and scheduled similarly regardless of the actions to be performed at each stop since the actual routing is generally not affected by what the truck driver does upon reaching each location along the route, especially in the case of delivering or picking-up non-perishable goods. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to utilize Borders' invention to schedule multiple pick-ups as well as deliveries in order to expand the services offered to its customers, thereby increasing Borders' customer base and potential for profit.

[Claims 32-36] Claims 32-36 recite limitations already addressed by the rejection of claims 1, 4-7, and 9 above; therefore, the same rejection applies.

[Claims 49-52] Claims 49-52 recite limitations already addressed by the rejection of claims 1, 4, 5, 7, and 9 above; therefore, the same rejection applies.

[Claims 71-73] Claims 71-73 recite limitations already addressed by the rejection of claims 1-3 above; therefore, the same rejection applies.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 3 and 73 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 22, 29, 33, 53, 56, and 59 of U.S. Patent No. 6,701,299 in view of the article "E-Business in the New Beverage Marketplace." The main difference between claims 3 and 73 of the instant application and claims 1, 22, 29, 33, 53, 56, and 59 of U.S. Patent No. 6,701,299 is the concept of scheduling reoccurring deliveries through one single request. However, as discussed in the art rejection above, the article "E-Business in the New Beverage Marketplace" explains how such an enhancement in light of claims 1, 22, 29, 33, 53, 56, and 59 of U.S. Patent No. 6,701,299 would be obvious.

### **Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Kobylevsky et al. (U.S. Patent No. 6,493,427) -- Discloses a remote prescription refill system that allows customers to specify desired prescription pick-up or delivery times.

Florence (US 2002/0007299) -- Discloses a method for scheduling of delivery of items using overlapping delivery windows.

"Consumers Continue to Select PETsMART.com as Their Favorite Internet Pet Site" -- Discusses "the Frequent Fetcher™ Home Delivery service which enables visitors to schedule their regular pet food purchases for automatic, repeat deliveries."

"E-Grocer Update" -- Discusses various home delivery services, including PETsMART.com and Webvan.

Archived PETsMART.com Web Site -- Discloses the regular home delivery option offered by PETsMART.com.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450**


or faxed to:

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**(703)305-7687** [Official communications; including  
After Final communications labeled  
"Box AF"]

**(703)746-7048** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7<sup>th</sup> floor receptionist.

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623  
March 30, 2004